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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,877	02/10/2004	Todd Simpson	87239/00004	8796

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EXAMINER
CHANKONG, DOHM

ART UNIT	PAPER NUMBER
2452	

MAIL DATE	DELIVERY MODE
08/18/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action *Before the Filing of an Appeal Brief*	Application No. *10/774,877*	Applicant(s) SIMPSON, TODD	
	Examiner DOHM CHANKONG	Art Unit 2452	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>03 August 2010</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

      Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

      NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/DOHM CHANKONG/
Primary Examiner, Art Unit 2452

Continuation of 11. does NOT place the application in condition for allowance because: The examiner has carefully considered Applicant's arguments and Applicant's arguments during the Applicant interview conducted on 7/7/2010. The examiner agrees that Gross likely does not teach Applicant's interpretation of the claim language. However, for the reasons outlined below, Applicant's interpretation of the claim language and arguments are not supported Applicant's own specification.

As a preliminary matter, Applicant indicated a desire to conduct another interview with the examiner and the supervisor if the examiner did not find Applicant's argument persuasive. However, considering that one interview was already conducted after the final rejection, a second interview is not proper because the examiner does not believe that such an interview would assist in placing the application in condition for allowance. See MPEP § 714.12 ("The prosecution of an application before the examiner should ordinarily be concluded with the final action. However, one personal interview by applicant may be entertained after such final action if circumstances warrant. Thus, only one request by applicant for a personal interview after final should be granted, but in exceptional circumstances, a second personal interview may be initiated by the examiner if in his or her judgment this would materially assist in placing the application in condition for allowance.")

If Applicant desires supervisory review, the proper course of action is to file a request for a pre-appeal conference that would enlist a panel of examiners to review the merits of Applicant's and examiner's positions. If Applicant is unfamiliar with this review procedure, more information can be found at: http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm

Moving on to Applicant's arguments, they all center on the limitation which recites "the receiver subsystem is configured to permit the sender subsystem to add a new category to a listing of receiver categories." All limitations are given the broadest reasonable interpretation consistent with Applicant's specification. MPEP § 2111. The ONLY language found in Applicant's specification which supports that particular limitation reads in full:

"However, Jane also has a '(New)' category, meaning that she is willing to negotiate (herself or through her agent) a new category for this sender such a category may only be exposed to this sender, not others, or it may be made public and available for all." 20040199593, 0031.

Since there is no other language that comes close to describing a sender adding a new category to the listing of receiver categories, the foregoing sentence provides the boundary for the interpretation of the limitation.

Applicant first argues that the examiner's position of interpreting a user/sender playing a role in controlling the subsystem to add a category is unreasonable. Applicant argues that the limitation clearly should only be interpreted as a subsystem acting independently of any user. During the 7/7 interview, the examiner made it clear that the claim language does not require such an interpretation and would need to be amended (e.g., "...sender subsystem, independently of sender, adds a new category..."). The examiner believes his interpretation is consistent with Applicant's specification which expressly states that the sender may act to add the new category (i.e., "...she is willing to negotiate (herself or through her agent)..."). It is clear that the if the sender if she negotiates herself, is not acting on her own. She uses the subsystem to add the category. Hence the subsystem, through the user, adds the category. This intepretation is consistent with Gross' teaching.
 Gross teaches a user using a PC to add a category to a receiver's listings. While acting under the control of the user, the PC is still carrying out the command of adding the category. Examiner's position is not that the user is part of the system but that the PC is carrying out the command of the user to add the category. There is no language that requires the sender subsystem to act independently, autonomously, automatically, etc. For example, consider the claim language "An email system sending an email to a receiver" versus "An email system sending, independent of a user, an email to a receiver." The first sentence does not preclude the interpretation that the email system could carry out the act of sending the email under the command of a user (who pushes the send button) while the second sentence clearly requires the system to act without user intervention.
Again, as stated during the interview, the claim should be amended to include language that requires the subsystem to act independently of a user.

Applicant then argues that even if examiner's interpretation were reasonable, Gross still fails to teach the claimed invention because Gross' invention discloses that "[a]ccepting or rejecting a category let alone adding a new category, always requires the action of the receiver." Applicant argument implies that the receiver is not part of the process of adding a category - that a sender simply adds a category. This argument is not supported by Applicant's specification which states that either the sender (Jane) or the agent must NEGOTIATE to add a new category. One of ordinary skill in the art would not interpret the term "negotiate" as simply the sender adding a category to the receiver's listing but instead require both the sender and the receiver to take part in the process. Therefore, Applicant is arguing an interpration of the limitation that is not found in the specification. To interpret the limitation in the manner suggested by Applicant would constitute new matter unless Applicant can cite specific sections in the specification which support Applicant's intepretation.

Finally, Applicant argues that Gross' process criteria are not analogous to the claimed category because the criteria "merely tells the system additional ways to process a message." Contrary to Applicant's argument, Gross clearly views categories as process criteria:

"Subscription servers may alert subscribers of new subscription categories, which the recipient may include as processing criteria..."[0055];
"The modified email program also permits messages to be associated with predefined criteria, including criteria permitting the assignment of categories to messages, as well as automatic processing of messaged in accordance with the predefined criteria" [0079];
"Publicly available processing criteria may be retrieved by any anonymous sender possibly not known to the recipient, and be used to categorize messages dispatched to the recipient" [0269].

All of the foregoing citations clearly state that process criteria are used to categorize messages.   Because they are used to categorize messages, then they can properly be interpreted as categories for the messages.